



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,592	12/13/2001	Victor B. Lortz	884.501US1	6044

7590 04/07/2006

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,592	LORTZ, VICTOR B.	
	Examiner	Art Unit	
	Zachary A. Davis	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A response was received on 19 January 2006. By this response, Claims 1, 5-9, 12, and 15-17 have been amended. No claims have been added or canceled. Claims 1-17 are currently pending in the present application.

Response to Arguments

2. Applicant's arguments filed 19 January 2006 have been fully considered but they are not persuasive.

Regarding the rejection of Claims 9-17 under 35 U.S.C. 101 as non-statutory, Applicant argues that the claims have been amended and "are directed to statutory subject" (page 8 of the present response). The Examiner respectfully disagrees. With respect to Claims 9-14, the claims still recite the broad limitation "machine-accessible medium", which is broad enough to encompass non-statutory embodiments. When a claim can include non-statutory embodiments, the claim as a whole is considered to be non-statutory. With respect to Claims 15-17, although Claim 15 has been amended to recite a method generating a digital signal instead of only claiming the signal itself, the claimed method does not produce a useful, concrete, and tangible result as required (see below).

Regarding the rejection of Claims 8 and 12 under 35 U.S.C. 112, second paragraph, the Examiner notes that the issues of indefiniteness noted in the previous

Art Unit: 2137

Office action have not been entirely addressed by the amendments. Specifically in reference to Claim 8, the Examiner notes that by the common definition of revoking a certificate, only the issuer of the certificate has the ability to revoke the certificate. However, Claim 8 recites the client revoking the at least one first certificate, when the client is not the issuer; rather, the authorizer is the issuer. Specifically in reference to Claim 12, the claim remains unclear as to the interpretation of "granting access to the third party". See below regarding the rejections under 35 U.S.C. 112 for further detail.

Claims 1-9 and 12-16 were rejected under 35 U.S.C. 102(e) as anticipated by McGarvey, US Patent 6643774. Claim 10 was rejected under 35 U.S.C. 103(a) as unpatentable over McGarvey in view of Eastlake et al, "XML-Signature Syntax and Processing", and Claims 11 and 17 were rejected under 35 U.S.C. 103(a) as unpatentable over McGarvey in view of Ellison et al, "SPKI Certificate Theory". Specifically in reference to Claim 1, and also to Claims 9 and 15, Applicant first argues that McGarvey does not disclose a second certificate that identifies the third party. The Examiner notes that there does not appear to be written description of such a limitation in the specification, as detailed below. Further, the Examiner believes that McGarvey does, in fact, disclose a certificate identifying the third party (see column 11, lines 51-55; column 10, lines 61-67; and column 9, lines 15-26, noting the server certificate, where the server corresponds to the claimed third party). Applicant further argues that the claimed invention "removes the need of the third party and the client to renew authorization after a period of time because the authorization is verifies [sic] with every transaction" and that McGarvey discloses systems that operate in a contrary manner

Art Unit: 2137

(page 9 of the present response). However, the Examiner believes that the description at the cited portion of McGarvey (column 12, lines 32-36) describing renewing tickets is not contrary to Applicant's invention, noting that Applicant's own specification discloses short term or one-time use certificates, which force the third party to get new authorization "after a short time" giving the client more control over the delegation of authorization (see paragraph 0025 of the present specification).

Further, regarding Claim 3, Applicant argues that McGarvey does not disclose a one-time use certificate; however, the Examiner believes that McGarvey does disclose a one-time use certificate (see column 8, lines 8-13, where a certificate can be for a specific unit of work). Regarding Claim 5, Applicant argues that McGarvey does not disclose limiting the third party's use of the first certificate; however, the cited portion of McGarvey clearly states that the authorization and trust given to the third party (implicitly by the certificates) is limited (column 8, lines 8-13).

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

Drawings

3. The objection to the drawings is withdrawn in light of the amended drawings.

Specification

4. Although Applicant has corrected the specific errors noted in the previous Office action, it appears that the specification still contains errors. Therefore, the objection to the specification is not withdrawn.

5. The disclosure is objected to because of the following informalities:

The specification appears to contain minor typographical and other errors. For example, in paragraph 0019, at the top of page 8, it appears that "SKPI" is intended to read "SPKI"; in paragraph 0027, at the bottom of page 10, it appears that in the phrase "the authorizer access the URI 810", "access" is intended to read "accesses"; and in paragraph 0030, on page 12, it appears that in the phrase "the above description it is intended to be illustrative", the word "it" should be deleted.

Appropriate correction is required. The above is not intended as an exhaustive list of errors. Applicant's cooperation is requested in correcting any other errors of which applicant may become aware in the specification.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the limitation in amended Claim 1, "wherein the at least one second certificate identifies the third party". See below regarding the rejection under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 9-14 are directed to a "machine-accessible medium" including a computer program ("instructions") for performing method steps. The term "machine-accessible medium" is broad enough to encompass, for example, a computer program written on paper. This is a computer program or data structure *per se*. Functional descriptive material such as a computer program *per se* that is not embodied in a computer readable medium is not statutory subject matter. See MPEP § 2106 IV.B.1(a).

Claims 15-17 are directed to methods, comprising a single step of generating a signal. Although a method clearly falls into one of the statutory classes of invention (process), the method does not produce a useful, concrete, and tangible result. The generation of a digital signal in and of itself is not a tangible result; further, it does not appear that there is a clear use for the signal by itself without providing for some function, for example, within a computer. See MPEP § 2106 IV.B.2.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, Claim 1 has been amended to recite the limitation "wherein the at least one second certificate identifies the third party". There does not appear to be any written description of this limitation in the specification, nor does there appear to be any mention of the second certificate identifying any device or party. Further, the specification explicitly states that authorization certificates are capable of delegating limited privileges to a third party *without revealing the identity of the third party* (see paragraph 0012 of the present specification); this appears to explicitly contradict the newly added claim limitation. Claims 2-8 are rejected due to their dependence on a rejected base claim.

11. The rejections of Claims 1-7, 9-11, 13, 14, and 16 under 35 U.S.C. 112, second paragraph, as indefinite are withdrawn in light of the amendments to the claims. As

Art Unit: 2137

noted above, the rejections of Claims 8 and 12 are maintained for the reasons detailed below.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the client not providing the at least one first certificate". There is insufficient antecedent basis for this limitation in the claim; further, the limitation is generally vague. Additionally, the claim recites "revoking, by the client, the at least one first certificate"; however, by the art-accepted definition of the term, a certificate can only be revoked by the issuer, and the client is not the issuer of the first certificate(s). Rather, the authorizer is the issuer, and therefore, the client would not be able to revoke the first certificate(s). This contradiction further renders the claim indefinite.

Claim 12 recites the limitation "granting access to the third party". It is unclear whether "granting access to the third party" is to be read as the third party is allowed to access another party such as the authorizer, or as another party being allowed to access the third party. That is, it is not clear if it is the third party that is given access to another party, or another party is given access to the third party. This renders the claim indefinite. For purposes of interpreting the prior art, the former interpretation is assumed.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-9 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by McGarvey, US Patent 6643774.

In reference to Claim 1, McGarvey discloses a method including a client storing a first certificate from an authorizer, the client storing a URI associated with the first certificate and a third party, the client providing a certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate to the authorizer upon the authorizer accessing the URI, in which the client retains control over the third party's use of the first certificate (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11).

In reference to Claims 2 and 3, McGarvey further discloses providing a short-term use certificate to the third party (column 12, lines 30-35; column 8, lines 8-13).

In reference to Claim 4, McGarvey further discloses authenticating the authorizer upon accessing the URI (column 11, lines 60-61).

In reference to Claims 5 and 6, McGarvey further discloses limiting and tracking the third party's use of the first certificate (column 8, lines 8-13).

In reference to Claim 7, McGarvey further discloses that the contents of the first certificate are not revealed to the third party (see column 11, lines 42-46).

In reference to Claim 8, McGarvey further discloses that the first certificate can be revoked (see column 12, lines 30-36).

In reference to Claim 9, McGarvey discloses a computer-implemented method including a client receiving a first certificate from an authorize, the client generating a URI associated with the first certificate and a third party, the client providing a second certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate to the authorizer upon the authorizer accessing the URI after the third party has provided the second certificate and URI to the authorizer (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11).

In reference to Claim 12, McGarvey further discloses that the third party is granted access to the authorizer (column 8, lines 4-19).

In reference to Claim 13, McGarvey further discloses tracking a use of the second certificate (column 8, lines 8-13).

In reference to Claim 14, McGarvey further discloses that the second certificate can be revoked (column 8, lines 10-13; column 12, lines 30-36).

In reference to Claims 15 and 16, McGarvey discloses generating a second digital certificate issued from a client to a third party (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11) and a URI capable of retrieving a first digital certificate from a database associated with the client (see column 12, lines 22-26).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Eastlake et al, "XML-Signature Syntax and Processing".

McGarvey discloses everything as applied above to Claim 9. However, McGarvey does not explicitly disclose the use of XML signatures. Eastlake discloses that XML signatures can be used to apply digital signatures to the content of resources that may be external to the signature itself (page 4, section 1.0, "Introduction"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of McGarvey to include the use of XML signatures, in order to provide integrity and message or signer authentication (see Eastlake, page 1, Abstract).

18. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Ellison et al, "SPKI Certificate Theory".

In reference to Claim 11, McGarvey discloses everything as applied above to Claim 9. In reference to Claim 17, McGarvey discloses everything as applied above to Claim 15. However, McGarvey does not explicitly disclose the use of SPKI certificates. Ellison et al disclose that authorization certificates can be used to delegate authorizations (page 14, section 4, "Delegation") and that SPKI certificates can be used to define an authorization certificate (page 13, section 3.3, "SPKI Certificates"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the systems and methods of McGarvey to include the use of SPKI certificates, in order to allow for authorizations to be delegated without needing to involve the owner of the resource concerned (see Ellison, page 14, section 4).

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

Art Unit: 2137

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


zad


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER